

ESTTA Tracking number: **ESTTA498077**

Filing date: **10/03/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Wayland Arnold Jennings Revocable Trust
Granted to Date of previous extension	10/03/2012
Address	c/o Loeb & Loeb, LLP 1906 Acklen Avenue Nashville, TN 37212 UNITED STATES
Attorney information	Tiffany Dunn Loeb & Loeb 1906 Acklen Avenue Nashville, TN 37212 UNITED STATES chdocket@loeb.com, nytrademark@loeb.com, tdunn@loeb.com, bschaffer@loeb.com Phone:(615) 749-8300

### Applicant Information

Application No	85326373	Publication date	06/05/2012
Opposition Filing Date	10/03/2012	Opposition Period Ends	10/03/2012
Applicant	Korban Music Group, LLC P. O. Box 905 Groesbeck, TX 76642 UNITED STATES		

### Goods/Services Affected by Opposition


Class 035. All goods and services in the class are opposed, namely: Record label services, namely, performing artist management, music business management, music business marketing; music distribution services, namely, distributorship in the field of records; record label development, namely, business management; Promoting the concerts of others; Production of advertising matter and commercials; Advertising on the Internet for others
Class 041. All goods and services in the class are opposed, namely: Entertainment and record label services, namely, music songwriting, recording, production and publishing, music video creation and production, artist development in the nature of musical training, music distribution, namely, providing non-downloadable prerecorded music; arranging and conducting of concerts; organizing events featuring live musical performances

### Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
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False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1551913	Application Date	12/12/1988
Registration Date	08/15/1989	Foreign Priority Date	NONE
Word Mark	WAYLON W		
Design Mark			
Description of Mark	THE DESIGN PORTION OF THE MARK CONSISTS OF THE LETTER "W" IN THE FORM OF A BIRD.		
Goods/Services	Class 016. First use: First Use: 1978/00/00 First Use In Commerce: 1978/00/00 NOVELTY PRINTED ITEMS AND PUBLICATIONS, NAMELY, BUMPER STICKERS, PLAYING CARDS, AND SONGBOOKS		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	
Goods/Services	Goods and services, including without limitation, musical recordings, clothing, live events and websites promoting musical recordings and other goods associated with Waylon Jennings, one of the most well-known country music recording artists in the world.

Attachments	73768616#TMSN.gif ( 1 page )( bytes ) 70817_CoverArt_WAYLONMUSICINSIDETRIBUT_300RGB.jpg Notice of Opposition - Waylon W.pdf ( 7 pages )(2373017 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Brittany A. Schaffer
Name	Brittany A. Schaffer, Esq.
Date	10/03/2012

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85326373: W WAYLON

Published in the *Official Gazette* of June 5, 2012 in International Classes 35 & 41

WAYLAND ARNOLD JENNINGS	)	
REVOCABLE TRUST,	)	
Opposer,	)	
	)	
v.	)	Opposition No.
	)	
KORBAN MUSIC GROUP, LLC	)	
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

The Wayland Arnold Jennings Revocable Trust (the “Opposer”), a Tennessee trust located and doing business c/o Loeb & Loeb LLP, 1906 Acklen Avenue, Nashville, Tennessee, believes it will be damaged by the registration of Applicant’s design mark W WAYLON,



(the “WAYLON Mark”), Application Serial No. 85326373 (the “Application”), and opposes the same.

As grounds for opposition, Opposer alleges:

1. Wayland Arnold Jennings, professionally known as Waylon Jennings, is one of the most well-known country music artists in the world. Opposer owns all intellectual property, including all trademark rights, of the late Waylon Jennings.

2. The WAYLON Mark has been well known in the United States and associated with Waylon Jennings since 1978, long before Applicant’s May 24, 2011, filing date for the Application. Opposer, by itself and through its licensees, has marketed various products and

services in interstate commerce under or in connection with its WAYLON Mark, including musical recordings, clothing, live events and websites promoting musical recordings and other goods associated with Waylon Jennings.

3. Opposer, by itself and through its licensees, has spent significant sums advertising and promoting Opposer's WAYLON Mark throughout the United States and has sold millions of dollars' worth of products and services with the WAYLON Mark around the world, including in the United States.

4. By virtue of the longstanding association of the WAYLON Mark with Waylon Jennings, the popularity of Opposer's WAYLON Mark products, and the advertising and promotion of its WAYLON Mark, Opposer has built up and now owns extremely valuable goodwill in its WAYLON Mark. Because of the foregoing, Opposer's WAYLON Mark has also developed secondary meaning among the relevant consuming public and distinctly identifies Opposer and its goods and services.

5. Opposer's predecessor in interest first registered the WAYLON Mark on August 15, 1989, Registration No. 1551913. Because Opposer inadvertently missed the deadline for filing a declaration under Section 8 of the Lanham Act, Opposer's registration was cancelled on March 20, 2010. However, Opposer has never stopped using the WAYLON Mark as a trademark on goods and services sold by Opposer and its licensees.

6. Upon information and belief, Applicant has had extensive, actual knowledge of Opposer's long-standing and continuing trademark use of the WAYLON Mark in commerce; Applicant's principal, Terry Jennings, is a son of Waylon Jennings.

7. On May 24, 2011, Applicant filed Application Serial No. 85326373 with the USPTO seeking registration of the WAYLON Mark. Applicant claimed it intends to use the

mark with (1) “Record label services, namely performing, artist management, music business management, music business marketing; music distribution services, namely, distributorship in the field of records; record label development, namely, business management; Promoting the concerts of others; Production of advertising matter and commercials; Advertising on the Internet for others” in International Class 35, and (2) “Entertainment and record label services, namely, music songwriting, recording, production and publishing, music video creation and production, artist development in the nature of musical training, music distribution, namely, providing non-downloadable prerecorded music; arranging and conducting of concerts; organizing events featuring live musical performances” in International Class 41.

8. Upon information and believe, Applicant is not using WAYLON Mark in commerce in the United States.

9. Any use by Applicant of the WAYLON Mark is without Opposer’s consent or authorization. Applicant is in no way sponsored, authorized, or licensed by, or in any other way legitimately connected with, Opposer with respect to the ownership, use, or control of the WAYLON Mark or other intellectual property or publicity rights of Waylon Jennings.

10. Registration by Applicant of the Application would be damaging to Opposer.

## **COUNT I**

### **LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. § 1052(D)**

11. Opposer realleges the allegations in Paragraphs 1 through 10.

12. Applicant’s use of the WAYLON Mark for the services set forth in Application Serial No. 85326373 is likely to result in confusion, mistake, and/or deception in that consumers are likely to believe Applicant’s services are Opposer’s services, or the services of a person or

company that is sponsored, authorized or licensed by, or in some other way legitimately connected with Opposer.

## **COUNT II**

### **SUGGESTION OF FALSE CONNECTION UNDER 15 U.S.C. § 1052(A)**

13. Opposer realleges the allegations in Paragraphs 1 through 12.

14. Since long before the filing date of the Application, and by virtue of Opposer's and its licensees' extensive use, advertising, and promotion of the WAYLON Mark in connection with various products and services related to Waylon Jennings, the WAYLON Mark has become extremely well-known and closely identified with Opposer and Waylon Jennings by consumers.

15. Applicant's applied-for intent-to-use mark is *identical* to WAYLON Mark, and will be understood by consumers to refer to Opposer, and consumers will erroneously believe that Applicant's WAYLON Mark and the services provided thereunder, are associated with or authorized by Opposer.

16. Opposer is not connected with Applicant's services, including without limitation, those promoted under the WAYLON Mark or similar marks, nor has Opposer authorized Applicant's use of the trademark, design, intellectual property, or publicity rights contained in the WAYLON Mark

17. Opposer's WAYLON Mark is sufficiently well-known and closely identified with Opposer such that Applicant's use and registration of the WAYLON Mark for the applied for services will falsely suggest to consumers a connection with Opposer.

18. Upon information and believe, Applicant intends through its intent to use and to register the WAYLON Mark to trade on the association of the WAYLON Mark with Opposer in violation of 15 U.S.C. § 1052(a).

### **COUNT III**

#### **DILUTION UNDER 15 U.S.C. § 1125(C)**

19. Opposer realleges the allegations in Paragraphs 1 through 18.

20. Opposer's WAYLON Mark became distinctive and famous in accordance with 15 U.S.C. § 1125(c) long before Applicant's filing date of May 24, 2011.

21. Applicant's proposed use of the *identical* mark in connection with Applicant's services is likely to tarnish and cause dilution of Opposer's famous WAYLON Mark by blurring the distinctive quality and harming the good will attained by Opposer's goods and services.

22. Use or registration of Applicant's proposed mark will hinder the ability of Opposer's mark to distinguish Opposer's goods and services.

23. Use or registration of Applicant's proposed mark will hinder Opposer's ability to protect the reputation and good will attained by Opposer's WAYLON Mark.

24. Likelihood of tarnishment and damage to Opposer's good will is strengthened by the fact that prospective customers of Applicant who encounter defects or a lack of quality in Applicant's goods or services may attribute those defects or such lack of quality to Opposer.

25. In view of the foregoing, Opposer will be damaged by the use or registration of Applicant's proposed mark and such registration should be denied.



**WHEREFORE**, registration by Applicant of the applied for mark would be damaging to Opposer.

Please debit our Deposit Account NO. 502547 for the \$600.00 filing fee and any additional necessary fees.

Please address all correspondence to Loeb & Loeb, LLP, 1906 Acklen Avenue, Nashville, TN 37212, Attn: Brittany A. Schaffer, Esq.

Date: October 3, 2012

LOEB & LOEB LLP

By: /s/ Brittany A. Schaffer  
Tiffany A. Dunn, Esq.  
Brittany A. Schaffer, Esq.  
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*Attorneys for Opposer*

## **CERTIFICATE OF SERVICE**

I, Brittany A. Schaffer, hereby certify that a copy of the **NOTICE OF OPPOSITION** has been served upon:

Korban Music Group, LLC  
P.O. Box 905  
Groesbeck, Texas 76642

via first class mail, postage prepaid, this 3rd day of October, 2012.

/s/ Brittany A. Schaffer